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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,192	06/24/2002	Beth E. Borowsky	59138-B-PCT-US/JPW/FIIB	4898

7590 11/17/2003

Cooper & Dunham
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New York, NY 10036

EXAMINER	
O HARA, EILEEN B	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

KC

Office Action Summary	Application No.	Applicant(s)	
	10/018,192	BOROWSKY ET AL.	
	Examin r	Art Unit	
	Eileen O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,19,36,47 and 58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-14, 19, 36, 47 and 58* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-14, 19, 36, 47 and 58 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, 5, 6, 8, 12, 19 and 36, in so far as they are drawn to nucleic acids encoding a human SNORF36a receptor of SEQ ID NO: 2 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1.

II. Claims 1-3, 5, 7, 9, 13 and 19, in so far as they are drawn to nucleic acids encoding a human SNORF36b receptor of SEQ ID NO: 4 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1.

III. Claims 1-3, 5, 7, 9, 13 and 19, in so far as they are drawn to nucleic acids encoding a rat SNORF36 receptor of SEQ ID NO: 8 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1.

IV. Claim 4, in so far as it is drawn to human SNORF36 genomic DNA, classified in class 536, subclass 23.5.

V. Claim 4, in so far as it is drawn to rat SNORF36 genomic DNA, classified in class 536, subclass 23.5.

VI. Claim 47, in so far as it is drawn to an antibody capable of binding to a human SNORF36a receptor of SEQ ID NO: 2, classified in class 530, subclass 388.22, for example.

VII. Claim 47, in so far as it is drawn to an antibody capable of binding to a human SNORF36b receptor of SEQ ID NO: 4, classified in class 530, subclass 388.22, for example.

VIII. Claim 47, in so far as it is drawn to an antibody capable of binding to a rat SNORF36 receptor of SEQ ID NO: 8, classified in class 530, subclass 388.22, for example.

IX. Claim 58, drawn to a nonhuman mammal comprising a homologous recombination knockout of the native mammalian SNORF36 receptor, classified in class 800, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related in that they appear to be allelic or splice variants of each other, however because there appears to be significant diversity between the two nucleic acid sequences, separate sequence searches would be required. Accordingly, restriction is proper.

Inventions I and II are both related to invention III in that inventions I and II are human SNORF36 nucleic acids, while invention III is the rat SNORF36 nucleic acid, and is therefore an ortholog to inventions I and II. Due to the differences in the sequences, a separate sequence search would be required for all three nucleic acids. Accordingly, restriction is proper.

Inventions I and II are related to invention IV in that the nucleic acid of invention IV is the genomic DNA corresponding to human SNORF36. Although the classification for the nucleic acid molecules are overlapping and the genomic sequence most likely comprises the coding sequence in non-contiguous segments, each represents a patentably distinct product with distinct physical and functional characteristics. The genomic sequence requires different

considerations to determine patentability from that of the other nucleic acid molecules, and may encode proteins other than that encoded by SEQ ID NO: 2 or 4. A reference against one sequence would not be a reference against the other. Accordingly, restriction is proper.

Invention III is related to invention V in that the nucleic acid of invention V is the genomic DNA corresponding to rat SNORF36. Although the classification for the nucleic acid molecules are overlapping and the genomic sequence most likely comprises the coding sequence in non-contiguous segments, each represents a patentably distinct product with distinct physical and functional characteristics. The genomic sequence requires different considerations to determine patentability from that of the other nucleic acid molecules, and may encode proteins other than that encoded by SEQ ID NO: 8. A reference against one sequence would not be a reference against the other. Accordingly, restriction is proper.

Inventions I and II are related to invention V in that inventions I and II are the human cDNAs encoding SNORF36 proteins, while the nucleic acid of invention V is the genomic DNA corresponding to rat SNORF36. Conversely, invention III is related to invention IV in the invention III is the cDNA encoding rat SNORF36, while invention IV is the human genomic DNA. The genomic and cDNA sequences have different DNA sequences and different physical and functional characteristics, and would require different searches and consideration. Accordingly, restriction is proper.

Inventions IV and V are related in that inventions are human and rat SNORF36 genomic DNA, respectively, and are therefore orthologs. Due to the differences in the sequences, a separate sequence search would be required for the two nucleic acids. Accordingly, restriction is proper.

Inventions VI-VIII are related in that they are antibodies to human SNORF36a, 36b or rat SNORF36 proteins. Due to the similarities in amino acid sequences of the three SNORF proteins, antibodies to the three proteins would probably cross-react with the other proteins. However, due to the differences, some antibodies that bind to one protein might not bind to the other proteins, and a separate sequence search would be required for each. Accordingly, restriction is proper.

Each of inventions I-V are unrelated to each of inventions VI-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the nucleic acids of inventions I-V are physically and functionally distinct chemical entities from those of the antibodies or transgenic animal of inventions VI-IX, and have different structures and activities.

Each of inventions VI-VII are unrelated to invention IX. The antibodies are physically and functionally distinct chemical entities from that of the transgenic animal.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, separate search requirements and/or divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. John White on Nov. 14, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Eileen B. O'Hara

Patent Examiner